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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91168463
Party	Plaintiff Randall Publishing Inc
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Submission	Other Motions/Papers
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Attachments	Notice of Filing Amended Complaint from Underlying Case in Support of Motion to Suspend Proceedings.pdf (14 pages)(3988735 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Randall Publishing Company, Inc.

Application No.: 78582076

Opposer,

v.

Opposition No.: 91168463

TR Information Publishers

Applicant.

**NOTICE OF FILING AMENDED COMPLAINT FROM THE UNDERLYING
DISTRICT COURT CASE IN SUPPORT OF OPPOSER'S MOTION TO SUSPEND
PROCEEDINGS PENDING OUTCOME OF FEDERAL LITIGATION**

Opposer, RANDALL PUBLISHING COMPANY, by and through its undersigned counsel, hereby files the attached Amended Complaint from the underlying District Court Case styled: TR Information Publishers, Inc., v. Randall Publishing Company, Inc., Case No.: 8:05-cv-00517-JSM-MSS, which is currently pending before the United States District Court for the Middle District of Florida, Tampa Division, in support of its Motion to Suspend Proceedings Pending Outcome of Federal Litigation.

Boyd Mustelie Smith & Parker

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CERTIFICATE OF SERVICE

WE HEREBY CERTIFY that a true and correct copy of the foregoing was served via Facsimile and U.S. Mail to **H. William Larson, Esq., and Ruth E. Freeburg, Esq.,** Larson & Larson, P.A., 11199 69th Street North, Largo, Florida 33773, this 25th day of July, 2006.

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IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF FLORIDA
TAMPA DIVISION

TR Information Publishers,

Plaintiff,

vs.

Case No. 8:05-cv-517-T-30MSS

Randall Publishing Company, Inc.,
and Randall-Reilly Publishing, L.L.C.,

Defendants.

Injunctive Relief Requested
Jury Trial

AMENDED COMPLAINT

Plaintiff sues Defendant and alleges:

Jurisdiction and Factual Allegations

1. This action arises under the Federal Trademark Act, 15 U.S.C. §§ 1051 et seq. and the Deceptive and Unfair Trade Practices Act, Fla. Stat. Ann. §§ 501.201 et seq. Jurisdiction is based upon 15 U.S.C. § 1121 and 28 U.S.C. § 1338. This Court has jurisdiction over Plaintiff's state law claim pursuant to 28 U.S.C. § 1367 and the doctrine of supplemental jurisdiction. Venue is proper pursuant to 28 U.S.C. § 1391.
2. Plaintiff is a partnership with a principle place of business located at P.O. Box 476, Clearwater, Pinellas County Florida, 33757. The partners comprising Plaintiff are Robert C.A. de Vos and Tracy A. Brice, both residents of Pinellas County, Florida.
3. Plaintiff is the owner of a valid trademark: *National Truck Stop Directory* for a printed publication concerning nationwide commercial trucking. A representative example of Plaintiff's trademark for the identified goods is set forth in **Exhibit A**.

4. Plaintiff's date of first use of its trademark in interstate commerce is November 18, 1986.

5. Plaintiff has used its *National Truck Stop Directory* trademark for a printed publication concerning nationwide commercial trucking continuously and exclusively since November 18, 1986. Plaintiff is the sole owner of the *National Truck Stop Directory* trademark for a printed publication concerning nationwide commercial trucking.

6. Plaintiff's *National Truck Stop Directory* trademark has been printed in yellow lettering on a blue background with red accents annually since November 18, 1986. Plaintiff's trade dress is non-functional.

7. As a direct and proximate result of Plaintiff's exclusive, continuous and extensive use of its *National Truck Stop Directory* trademark in interstate commerce for a printed publication concerning nationwide commercial trucking, the Plaintiff's trademark has acquired a secondary meaning and distinctiveness among the relevant consuming public and has come to identify Plaintiff's publication as a product emanating exclusively from Plaintiff. Plaintiff has never abandoned use of its trademark or trade dress.

8. Defendant Randall Publishing Company ("Randall") is a corporation with a principal business address located at 3200 Mine Road N.E., Tuscaloosa, AL 35406.

9. Defendant Randall-Reilly Publishing, L.L.C. ("Randall-Reilly") is a limited liability company with a principal business address located at 3200 Mine Road N.E., Tuscaloosa, AL 35406.

10. Defendant Randall, without right or authority or consent from Plaintiff, used Plaintiff's *National Truck Stop Directory* trademark and trade dress for identical competing

goods and services on or about February 2005. A representative example of Defendant Randall's unauthorized use of Plaintiff's *National Truck Stop Directory* trademark for a printed publication concerning nationwide commercial trucking is set forth in **Exhibit B**.

11. Defendant Randall-Reilly, on information belief, is successor in interest by merger to Defendant Randall, who without right or authority or consent from Plaintiff, uses the trademark *Truck Stop Directory* and trade dress which is confusingly similar to Plaintiff's *National Truck Stop Directory*. Representative examples of Defendant Randall-Reilly's unauthorized use of Plaintiff's *National Truck Stop Directory* trademark and trade dress for a printed publication concerning nationwide commercial trucking is set forth in **Exhibit C** and **Exhibit D**.

12. Defendants, prior to using *National Truck Stop Directory* and *Truck Stop Directory* and trade dress, had actual knowledge of Plaintiff's long established, continuous and exclusive use of the *National Truck Stop Directory* trademark and trade dress, and Plaintiff's claim of exclusive ownership of the trademark and trade dress.

13. On or about August 2000, July 2001 and July 2003, Plaintiff and Defendant Randall Publishing Company, Inc. had negotiations whereby Defendant Randall attempted to acquire Plaintiff's *National Truck Stop Directory* trademark. The negotiations between Plaintiff and Defendant Randall did not result in a license, assignment or any transfer of trademark rights from Plaintiff to Defendant Randall.

14. Defendants, unable to purchase Plaintiff's trademark and trade dress from Plaintiff, and despite having full knowledge of Plaintiff's superior and exclusive rights in the *National Truck Stop Directory* trademark and trade dress, purposefully and intentionally

started using Plaintiff's trademarks and trade dress in total disregard for the trademark rights of Plaintiff.

Count I – Federal Trademark and Trade Dress Infringement and Dilution

15. Plaintiff incorporates by reference the allegations contained in paragraphs 1 through 14 above.

16. Defendants' unauthorized use of Plaintiff's trademark and trade dress constitutes federal trademark and trade dress infringement under the Trademark Act, 15 U.S.C. § 1125(a). Defendant's unauthorized use of Plaintiff's *National Truck Stop Directory* in connection with a printed publication concerning nationwide commercial trucking is a false and misleading description and representation of fact which is likely to cause confusion, deception and mistake in Plaintiff's customers and potential customers as to the origin, affiliation, sponsorship or approval of Plaintiff's goods and services and those of Defendants, all of which damages Plaintiff.

17. Defendants' unauthorized use of Plaintiff's trademark constitutes federal trademark dilution under the Trademark Act, 15 U.S.C. § 1125(c). Defendants' unauthorized use of Plaintiff's *National Truck Stop Directory* in connection with a printed publication concerning nationwide commercial trucking has caused dilution of the acquired distinctiveness of the mark.

18. Said acts of infringement and dilution by Defendants is causing and will continue to cause irreparable injury to Plaintiff if the Defendants are not enjoined by this Court from infringement of Plaintiff's trademark rights, and Plaintiff has no adequate remedy at law.

19. All conditions precedent have been met prior to the filing of this action.

Count II – Violation of Florida’s Deceptive and Unfair Trade Practices Act

20. Plaintiff incorporates by reference the allegations of paragraphs 1 through 19 above.

21. Defendants’ unauthorized use of Plaintiff’s trademark constitutes violation of Florida’s Deceptive and Unfair Trade Practices Act under §§ 501.201 et seq. Defendants’ unauthorized use of Plaintiff’s trademark in connection with a printed publication concerning commercial trucking is a false and misleading description and advertisement, upon which the relevant consumers can reasonably be expected to rely.

22. It was the intent of Defendants that the relevant consumers rely upon the false information provided in connection with Defendants’ unauthorized use of Plaintiff’s trademark.

23. The relevant consumers have been injured by the false information provided in connection with Defendants’ unauthorized use of Plaintiff’s trademark.

24. Plaintiff has been damaged by the unfair, unconscionable and deceptive actions of Defendants.

Count III – Injunctive Relief

25. Plaintiff incorporates by reference the allegations of paragraphs 1 through 24 above.

26. By the acts complained of herein, Plaintiff is entitled to injunctive relief under section 34 of the Trademark Act, 15 U.S.C. § 1116, restraining Defendants, their agents and employs from infringing Plaintiff’s trademark.

27. By the acts complained of herein, Plaintiff is entitled to injunctive relief under The Florida Deceptive and Unfair Trade Practices Act, Fla. Stat. Ann. §§ 501.201 et seq.

WHEREFORE, Plaintiff demands judgment against Defendants as follows:

(a) That a preliminary and permanent injunction be entered against the Defendants enjoining the further unauthorized use of the *National Truck Stop Directory* trademark and trade dress or any colorable imitation thereof, for a printed publication concerning nationwide commercial trucking. Said preliminary and permanent injunction should read as follows:

Defendants, their officers, agents, servants, employees and attorneys, and those in active concert or participation with them who receive actual notice of this order are enjoined from advertising or using the trademark *National Truck Stop Directory*, and trade dress comprised of yellow lettering on a blue background with red accents, or any colorable imitation thereof, for a printed publication concerning nationwide commercial trucking.

(b) That judgment be entered against Defendants for all damages suffered by Plaintiff by reason of the Defendants' dilution and infringement of the Plaintiff's trademark and trade dress.

(c) That Plaintiff be awarded (1) Defendants' profits; (2) any damages sustained by Plaintiff; and (3) costs of the action pursuant to section 35 of the Trademark Act, 15 U.S.C. § 1117(a).

(d) That Plaintiff be awarded treble damages pursuant to section 35 of the Trademark Act, 15 U.S.C. § 1117(a).

(e) That Plaintiff be awarded a reasonable attorney's fee as a result of this action constituting an "exceptional case" pursuant to section 35 of the Trademark Act, 15 U.S.C. § 1117(a).

(f) That, pursuant to 15 U.S.C. § 1125(c)(2), Plaintiff be awarded the remedies set forth in 15 U.S.C. § 1117(a) and 1118, for Defendants' willful intention to trade upon

the reputation of Plaintiff.

(g) That the Court order the destruction of infringing articles used by Defendants pursuant to section 36 of the Trademark Act, 15 U.S.C. § 1118.

(h) That judgment be entered against Defendants for all damages suffered by Plaintiff by reason of the Defendants' violation of the Florida Deceptive and Unfair Trade Practices Act.

(i) That the Court, pursuant to Fla. Stat. Ann. §521.2105, award reasonable attorney fees and costs as a result of Defendants' violation of the Florida Deceptive and Unfair Trade Practices Act.

(j) That the Court award any other such relief that is equitable and just under the circumstances.

(k) A trial by jury.

Respectfully submitted,

/H. William Larson/
H. William Larson, Esq.
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Certificate of Service

I hereby certify that on April 25, 2006, I electronically filed the foregoing with the Clerk of the Court by using the CM/ECF system which will send a notice of electronic filing to Diana Vizcaino, Esq., Boyd Mustelier Smith & Parker, 100 S.E. Second St., 36th Floor, Miami, FL 33131.

s/Ruth E. Freeburg
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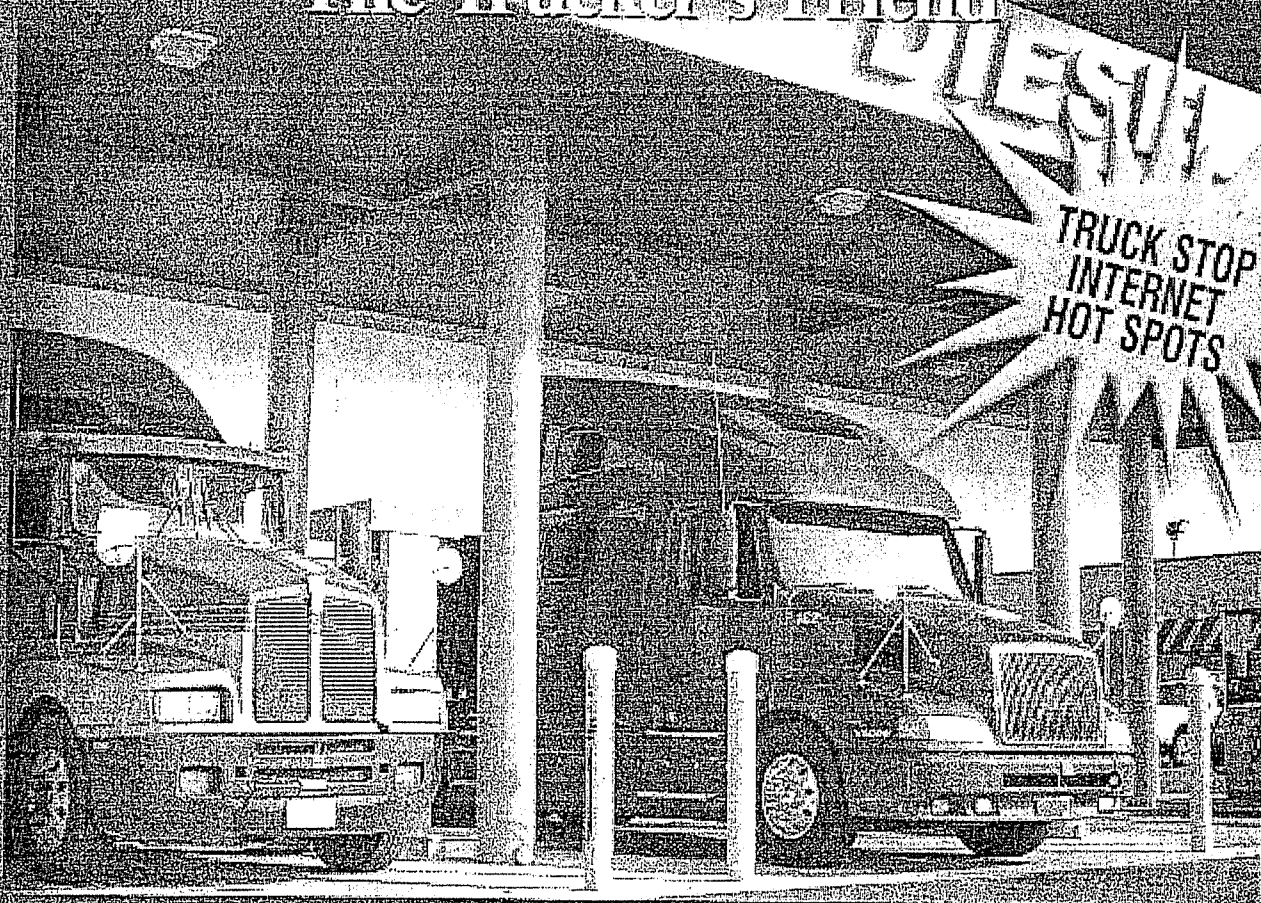
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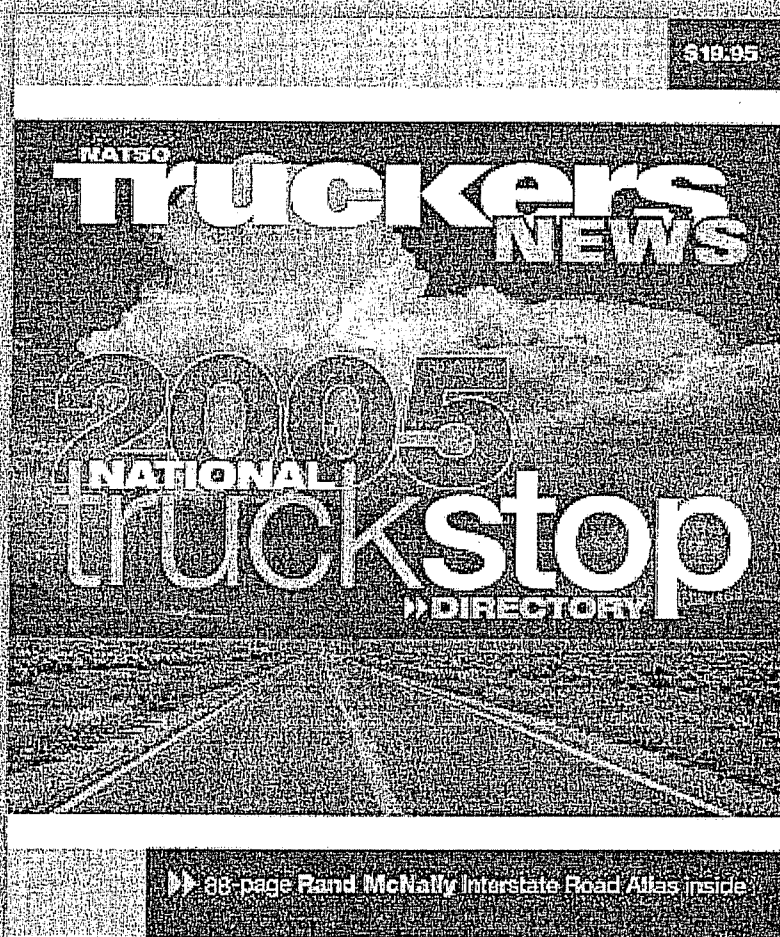


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